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SHUMAKER & SIEFFERT, P. A. 1625 RADIO DRIVE SUITE 300 WOODBURY, MN 55125				ALTER, ALYSSA MARGO
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/731,869  
Filing Date: December 09, 2003  
Appellant(s): WAHLSTRAND ET AL.

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Jessica Kwak  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed April 17, 2009 appealing from the Office action mailed June 20, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Claims 45 rejected under 35 U.S.C. 102(e) as being anticipated by Berrang et al. (US 6, 358, 281 B1).

## **NEW GROUND(S) OF REJECTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5 and 26 stand rejected and claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berrang et al. (US 6, 358, 281 B1). Berrang et al. discloses the claimed invention except for a recharge coil that encircles both modules. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the coil around the two modules, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70 (see MPEP 2144.04)

### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

### **(8) Evidence Relied Upon**

US 6,358,281

Berrang et al.

US Patent Publication 20040173221 A1	Singhal et al.	10/731,868
US Patent Publication 20040176673 A1	Wahlstrand et al.	10/731,867
US Patent Publication 20040176814 A1	Singhal et al.	10/730,873
US Patent Publication 20040172090 A1	Janzig et al.	10/731,699
US Patent Publication 20040176817 A1	Wahlstrand et al.	10/731,638
US Patent Publication 20040176816 A1	Singhal et al.	10/730,878

## **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-4, 6-9, 11-25, 27-30, 33-44, 46-49, 51-54 and 56 stand and 58-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Berrang et al. (US 6, 358, 281 B1). Berrang et al. discloses a first and second modules disposed within corresponding first and second housing in addition to the pliable (or bendable) bridge, which the examiner considers to be an overmold, that partially encapsulates the substantially cylindrical first and second housing as depicted in figure 1. The pliable (or bendable)

bridge allows “the surgeon to bend said bridge so as to better fit the two housing sections to the curved surface of the skull”(col. 3, lines 35-37). Therefore the pliable bridge has a plurality of degrees of freedom. The examiner considers the first module to be housing 3, which contains the electronics 21 as seen in figure 2. The examiner considers the second module to be housing 2, which contains the rechargeable battery 18.

In addition to the two modules in the overmold there is also an additional module, a housing for the coil 4 as seen in figure 1. Figures 15-18 depict the two modules and the third module, containing the coil, in alternative embodiments of linear and triangular structure. In the triangular configurations, as depicted in figures 15 and 16, the third module, coil 4, is connected to the overmold by a flexible tether.

In figure 1, “the housing sections 2 and 3 and bridge structure 6 are preferentially coated with gold, and, in a further embodiment, further coated with titanium, platinum, medical grade silicone, or any combination thereof”(col. 9, lines 58-62). Therefore the overmold does comprise at least two materials, e.g. one being gold and the other being silicone. 33

Also seen in figure 1, the proximal end of lead 8 connects to the lead connection module disposed within the overmold. The connection is between the bridge 6 and the lead junction 16. Lead 8 also has an electrode 10 disposed at the distal end.

As to claims 22, 38, 41 and 54, it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires

the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claim 55 stands rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Berrang et al. (US 6, 358, 281 B1). Since Berrang et al. discloses a totally implantable system, it would necessarily include a pulse generator that is associated with the electronics 21.

In the alternative, Berrang et al. discloses the claimed invention except for the pulse generator. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the electronics as taught by Berrang et al. with a pulse generator since it was known in the art to employ pulse generators in a completely implantable system, specifically auditory stimulation devices.

2. Claims 5, 10, 26, 31, 45, 50 and 57 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Berrang et al. (US 6, 358, 281 B1). Berrang et al. discloses the

claimed invention except for a recharge coil that encircles both modules. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the coil around the two modules, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70 (see MPEP 2144.04)

As to claims 10, 31, 50 and 57, Berrang et al. et al. discloses the claimed invention except for the helix tether. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lead as taught by Berrang et al. with a helix shaped lead since it was known in the art that helix shaped leads reduce the slack in the lead.

#### **(10) Response to Argument**

Appellant's arguments filed April 17, 2009 have been fully considered but they are not persuasive.

The Appellant argues for claims 1-4, 12-13, 16-18, 20-25, 33, 35, 37-38, 42-44, 51, 53-55, that Berrang et al. does not disclose a first module located in a first housing and a second module located in a second housing. On the contrary, Berrang et al. does in fact discloses two separate housings as disclosed in col. 3, lines 32-33, "said housing comprises two sections" and further refers to the housing as two housing sections. Therefore, Berrang et al. does disclose a first and second housing.

Additionally, the Appellant argues that Berrang et al. does not teach an overmold. As stated in the previous Office Action, the examiner considers the pliable bridge 6 to be an overmold. The bridge partially encapsulates, and thus unites, the edges of the

two separate housings. This partial encapsulation can be seen in the figures, for example figures 2 and 4.

As to claims 6-10, 27-31 and 46-50, the Appellant argues that there is no housing for the recharge coil. However, as seen in figure 1, there is an additional module with a housing for the coil 4. Figures 15-18 depict the two modules and the third module, containing the coil, in alternative embodiments of linear and triangular structure. As seen in these figures, particularly figure 17, the coil is partially encapsulated by the overmold.

As to claims 9, 30 and 49, As previously stated, onle of the embodiments, the triangular configurations, as depicted in figures 15 and 16, the third module, coil 4, is connected to the overmold by a flexible tether and thus located outside of the flexible overmold.

As to claim 11, the Appellant argues the Berrang et al. does not possess and overmold that completely encapsulates the first and second modules. However, the examiner considers the overmold to completely and at least partially encapsulates the first and second module.

As to claim 14, the Appellant argues that Berrang et al. does not disclose comprises silicone. However, as previously indicated by the examiner, Berrang et al. discloses the pliable bridge or overmold is "coated with silicone" and thus meets the limitation of the overmold being comprised of "silicone".

As to claim 15, the Appellant argues that Berrang et al. does not present an overmold that is comprised of two materials. However, as previously indicated by the

examiner, "the housing sections 2 and 3 and bridge structure 6 are preferentially coated with gold, and, in a further embodiment, further coated with titanium, platinum, medical grade silicone, or any combination thereof" (col. 9, lines 58-62). Therefore the overmold does comprise at least two materials, e.g. one being gold and the other being silicone, since they are both incorporated into the overmold.

As to claims 19, 36 and 52, The Appellant argues that the device of Berrang et al., among other things, does not possess hermetic feedthroughs. However, Berrang et al. discloses "hermetically sealed electrical lead-throughs" (col. 3, lines 39-40) and "some of said components may be comprised of non-biocompatible materials, they require complete hermetic or hermetic like sealing on all surfaces" (col. 3, lines 50-53). Therefore, Berrang et al. does disclose a hermetic feedthrough.

As to claims 34 and 39-41, Appellant also argues that Berrang et al. fails to disclose a "hermetic interconnect member". However as previously stated by the examiner, the pliable bridge unites the two housings and as a result acts as a hermetic interconnect member.

As to claim 45, the examiner appreciates the Appellant indicating that claim 45 should have been placed with claims 5 and 26. Accordingly, new grounds of rejection are submitted including claim 45 in the 103(a) rejection of claims 5 and 26.

As to claim 56, the Appellant again argues that there is no housing for the module containing the coil. However as previously stated, in figure 1, there is an additional module with a housing for the coil 4. Figures 15-18 depict the two modules and the third module, containing the coil, in alternative embodiments of linear and

triangular structure. As seen in these figures, particularly figure 17, the coil is partially encapsulated by the overmold.

As to claims 58-61, the Appellant argues that Berrang et al. does not disclose a hermetic housing. As disclosed by Berrang et al. does disclose the employment of hermetic housings.

As to claims 5 and 26 (and now claim 45), Appellant argues that it would not be obvious to rearrange the coil to encircle the components. The examiner respectfully disagrees and further indicates that the claim recites the limitation “substantially encircles”.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner’s answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

**(1) Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR

41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

**(2) Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Alyssa M Alter/  
Examiner, Art Unit 3762

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

/DONALD HAJEC/  
Director, Technology Center 3700

Conferees:

/Scott M. Getzow/

Primary Examiner, Art Unit 3762

/Angela D Sykes/

Supervisory Patent Examiner, Art Unit 3762